

**REMARKS**

This is in response to the Office Action mailed December 9, 2004.

New claim 31 is added in order to specify a particular aspect of the present invention. Support for new claim 31 is in the specification at, e.g., page 2, lines 19-23 and Example 1, Table 1.

**35 USC §102**

Reconsideration and withdrawal of the rejection of claims 14, 21-23 and 27 under 35 USC §102(b) as being anticipated by Liu are respectfully requested.

Preliminarily, it is respectfully submitted that the present rejection is the latest in a continuing series of improper piecemeal rejections. The present application has pended for well over six years, and the outstanding Action is the *tenth* Action in the case; the *fifth* Action since the claims were found free from the prior art on May 24, 2002; and applies new references subsequent to the claims having been allowed on March 24, 2004. The present rejection is an improper piecemeal examination:

To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. ***Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.***

MPEP §706.07 (emphasis added). Rejecting the present claims under a reference that was ostensibly searched for subsequent to applicant's response to the March 24, 2004 Action in which those claims were allowed is certainly switching references at the eleventh hour, and defeats the goal of reaching a clearly defined issue for an early termination.

The process is particularly inappropriate when it is considered that the current Action has misapplied the reference by ignoring claim terms. Liu, while disclosing copolymers of ethylene and propylene, is totally silent as to their molecular weight. Present claim 14 recites that the ethylene/propylene copolymers have a viscosity average

molecular weight of from about 4,000 to about 30,000. The Action notably does not even mention, much less deal with, that limitation. The Action does not, and indeed cannot, point to any disclosure in Liu of the claimed molecular weight range. Therefore, contrary to the Action's assertion that Liu's copolymers "read on applicant's," there is no anticipation without a disclosure of the claimed molecular weight range. The same is true of the narrower molecular weight range recited in claim 21. Finally, because of the lack of molecular weight disclosure in Liu, it cannot be said that the properties recited in claims 21 and 22 are inherent in the reference. The rejection is defective on its face, and should be withdrawn.

**Double Patenting**

Reconsideration and withdrawal of the rejection of claims 14-28 and 30 for obviousness-type double patenting over claims 1 and 7 of the '128 patent in view of the abstract of JP '942 are respectfully requested. That combination does not make out a *prima facie* case of

obviousness of any of the rejected claims, and is defective in several respects.

First, the Action relies on component (C) of claim 1 of the '128 patent as teaching the presently claimed ethylene/propylene copolymer component (i.e., component (a) in present claim 14). In particular, the Action focuses on the disclosure of a number average molecular weight of 500-15,000. However, that material is expressly stated in claim 1 of the '128 patent to be a *liquid* ("between about 3 and about 27 phr of a *liquid* ethylene/propylene/nonconjugated diene terpolymer"), whereas the presently claimed material is a *solid* ("and being a *solid* at room temperature"). The Action fails even to acknowledge that difference, much less does it offer any explanation for why one would ignore the liquid limitation, and substitute the solid material of the present claims. There is no motivation to do so apparent from claims 1 or 7 of the '128 patent, or from the abstract of JP '942.

The combination is further defective in failing to teach the presently-claimed amounts of the respective monomers in the polymer. It is well-established that it is

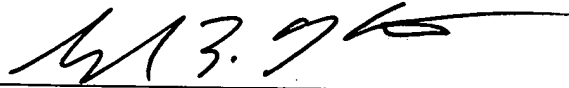
the claims that are compared in assessing double patenting. *Ortho Pharmaceutical Co. v. Smith*, 959 F.2d 936, 22 USPQ2d 1119 (Fed. Cir. 1992). Present claim 14 recites that ethylene is present in an amount of from 67% to about 75% by weight; the polyene from about 0% to about 30% by weight; and the  $\text{CH}_2=\text{CHQ}$  component from about 15% to about 40% by weight. In contrast, claim 1 of the '128 patent merely recites "an ethylene/propylene/non-conjugated diene terpolymer." Claims 1 and 7 of the '128 patent are silent as to the proportions of the monomers present, and thus cannot be viewed as suggesting the presently-claimed proportions. The abstract of JP '942 is no better, and cannot fill in that gap. The combination does not make out a *prima facie* case of obviousness of any of the rejected claims.

Applicant submits that the present application is in

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condition for allowance. Reconsideration and favorable  
action are earnestly requested.

Respectfully submitted,



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